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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,990	10/30/2003	Donald E. Weder	8403.989	2368
30589	7590	09/09/2005	EXAMINER	
DUNLAP, CODDING & ROGERS P.C.			SIPOS, JOHN	
PO BOX 16370			ART UNIT	
OKLAHOMA CITY, OK 73113			PAPER NUMBER	

3721

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/697,990	<b>Applicant(s)</b> WEDER ET AL.	
	<b>Examiner</b> John Sipos	<b>Art Unit</b> 3721	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/30/03</u> . | 6) <input type="checkbox"/> Other: ____.  |

## ***REJECTIONS OF CLAIMS BASED ON FORMAL MATTERS***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are directed to the "knowledge" of an individual and as such cannot be covered by a patent. Furthermore, this knowledge and its use is nothing more than the intended use for the wrapper that may or may not take place.

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The following is a quotation of the second paragraph of 35 U.S.C. ' 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-23** are rejected under **35 U.S.C. ' 112, second paragraph**, as being **indefinite** for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble of each of the claims is directed to the "selling and distributing" of sheet of material while most of the claims are directed to the wrapping method/apparatus of the flowerpots. The preamble should be amended to reflect the claimed subject matter.

The scope of each of claims 3-8 and 11-23 is unclear since they merely recite a structure without positively setting forth the manipulative of the process as required by a method claim. Due to this form of the claims and the use of such terms as "to allow" something to occur, the claims merely set forth that the

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structure may operate in a certain manner without actually performing the steps of the process.

Claims 9-23 are indefinite in that it is not clear to whom the "knowledge" refers. It is assumed that this refers to the seller; however, the claims should so state. Furthermore, the customer use for the wrapper is not, and cannot be, positively known to the seller in the selling and distributing of the sheet. The customer may use the sheet for any purpose he desires and in fact may never use it to wrap flowerpots.

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### ***DOUBLE PATENTING REJECTION***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-23 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the following

Claims 1 and 2 of U.S. Patent No. 6,860,085

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Claims 1-6 of U.S. Patent No. 6,370,840

Claims 1-6 of U.S. Patent No. 6,112,500

Claims 1-5 of U.S. Patent No. 5,761,879

Claims 1-24 of U.S. Patent No. 5,740,656

Claims 7-17 & 33-38 of U.S. Patent No. 5,727,362

Claims 36 & 37 of U.S. Patent No. 5,661,952

Claims 1-33 of U.S. Patent No. 5,632,131

Claims 1-6 of U.S. Patent No. 5,623,807

Claims 1-6 of U.S. Patent No. 5,617,702

Claims 1-36 of U.S. Patent No. 5,609,009

Claim 1 of U.S. Patent No. 5,590,508

Claims 1-10 of U.S. Patent No. 5,588,277

Claims 1-12 of U.S. Patent No. 5,551,140

Claims 9-17 of U.S. Patent No. 5,531,058

Claims 32-73 of U.S. Patent No. 5,426,914

Claims 1 & 2 of U.S. Patent No. 5,417,033

Claims 1-3 of U.S. Patent No. 5,105,599

Application 11/040,369 (provisional double patenting)

Although the conflicting claims are not identical, they are not patentably distinct from each other because a person having ordinary skill in the art would have found the claims of the instant application to be obvious variations of the claims of the patents. The claims of the patents and the claims of the present application are both directed to the same subject matter of using a decorative

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wrapping sheet to wrap flowerpots. While the claims of the present application and the claims of the patents may have variations and differences in their scope and terminology, the variations and differences would have been obvious to one having ordinary skill in the art. Regarding the "selling and distributing" of the sheet of material, this is considered an every day, common usage for any product used by consumers and Examiner takes Official Notice that this is well known in the packaging art. It would have been obvious to one skilled in the art to sell and distribute the wrappers recited in the claims of the above patents and then use them in the claimed wrapping operation.

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### ***REJECTIONS OF CLAIMS BASED ON PRIOR ART***

The following is a quotation of 35 U.S.C. ' 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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**Claims 1-23** are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Bell (2,971,312) or Snead (3,531,910).

The patent to Bell shows the wrapping of flowerpots by lowering a flowerpot into a wrapper that is placed over a structure 6 with an opening. The patent to Snead shows a plant wrapping apparatus that comprises a platform 32

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with an opening, a wrapper 64 positioned above the platform and an fastening means below the platform that automatically applies a twine to the wrapped plant once the plant is pushed into the wrapper and the opening. The specific article being wrapped is given little patentable weight since it doesn't affect the structure and it would have been obvious to one skilled in the art to wrap any article in the apparatus of Snead. The Snead process includes the manual tying of the twine about the article and since mechanical tying means are well known in the art, the use of an automated mechanism instead of a manual operation would have been obvious to one of ordinary skilled in the art. Regarding the "selling and distributing" of the sheet of material, this is considered an every day, common usage for any product used by consumers and Examiner takes Official Notice that this is well known in the packaging art. It would have been obvious to one skilled in the art to sell and distribute the wrappers of the above patents and then use them in the wrapping operation.

Furthermore, since the process disclosed by Bell is used in a flower shop that would require a supply of wrappers it would have been obvious to one skilled in the art to purchase the desired wrappers from a supplier.

Regarding claims 3-23, little patentable weight is given the various structures set forth in the these claims since no manipulative steps are recited and since they are directed to the possible usage of the structures that may or may not be used as claimed.

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***ADDITIONAL REFERENCES CITED***

The cited prior art is made of record but has not been relied upon in the rejection of claims. However, the prior art is considered pertinent to applicant's disclosure.


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Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **(703) 308-1882**. The examiner can normally be reached from 6:30 AM to 4:00 PM Monday through Thursday.

The **FAX** number for Group 3700 of the Patent and Trademark Office is **(703) 872-9302**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703) 308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-1148.

  
**John Sipos**  
**Primary Examiner**  
**Art Unit 3721**

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